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Remarks

Claims 1-21 and 23 are in the case. Claims 1, 2, 15, 16, 21, and 22 stand rejected. Claims 3-14 and 17-20 stand allowed or allowable if re-written in independent form. Of the rejected claims, claims 1, 2, and 21 have been amended herein, claim 22 has been canceled and claim 23 is new. The amendment to claim 1 was solely for grammatical reasons and does not narrow its scope

35 U.S.C. §103(a) CLAIMS REJECTIONS

I. Legal Standards Of Obviousness Under 35 U.S.C. § 103(a)

The Statutory standard for the ultimate determination of obviousness provides that a claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. 35 U.S.C. § 103 (1994); *Graham v. John Deere* 383 US 1, 13.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The mere fact that references can be combined or modified does

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not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis added).

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). The showing of a motivation to combine or modify prior art must be clear and particular, and broad conclusory statements about the teachings of one or more references, standing alone, are not "evidence." *In re Dembiczak*, 175 F.3d 994, 1000, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Second, there must be a reasonable expectation of success. Whether an art is predictable or whether the proposed modification or combination of the prior art has a reasonable expectation of success is determined at the time the invention was made. *Ex parte Erlich*, 3 U.S.P.Q.2d 1011 (Bd. Pat. App. & Inter. 1986).

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

II. Rejection Of Claims 1, 2, 15, And 16

Claims 1, 2, 15, and 16 stand rejected under 35 U.S.C. §103(a) as being obvious over combinations of references that each include U.S. Patent No. 3,653,697 to Ernst, hereinafter

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"Ernst." Claim 1 is independent, and claims 2, 15, and 16 depend from claim 1. The applicant traverses the rejection of claims 1, 2, 15, and 16 for at least the following reasons.

A. There Is No Motivation To Combine Ernst With Willson et al.

The Examiner asserts that Ernst discloses "a joint including a third sleeve (36, see figure 9) adapted to be secured to a second rake handle (24)." However, Ernst does not disclose a joint for a rake or any other implement handle, or even a movable joint. Rather, Ernst discloses a static, welded joint between two structural elements. As understood, the joint of Ernst is fixed in all respects. The purpose of Ernst is to form a prefabricated, strong, fixed joint between two structural elements. It has an International Class of F16B, which consists of "devices for fastening or securing constructional elements or machine parts together, e.g. nails, bolts, circlips, clamps, clips, wedges; joints or jointing." The structural elements of Ernst neither rotate with respect to each other, nor pivot with respect to one another. Rather, the joints of Ernst are welded together. One skilled in the art of garden implements would simply not look to Ernst when solving the problems associated with raking and disposing of debris. As such, there is no motivation to combine Ernst with Wilson, et al.

B. Ernst Does Not Disclose, Teach, or Suggest a Third Sleeve as Required by Claims 1, 2, 15, and 16.

Claim 1, and thus dependent claims 2, 15, and 16, require a third sleeve adapted to be secured to a second rake handle. In Ernst, the purported "third sleeve" (36) is not adapted to be connected to anything. The function of the purported sleeve is merely to take up space if the outer diameter of the structural element 24 is smaller than the supporting or bracing tube (18) in the first structural member. In addition, the purported "third sleeve" (36) does not rotate within

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the bracing tube (18). The entire teaching of Ernst regarding the purported "third sleeve" is contained in FIG.9, itself and the paragraph describing FIG. 9, both of which are reproduced below..

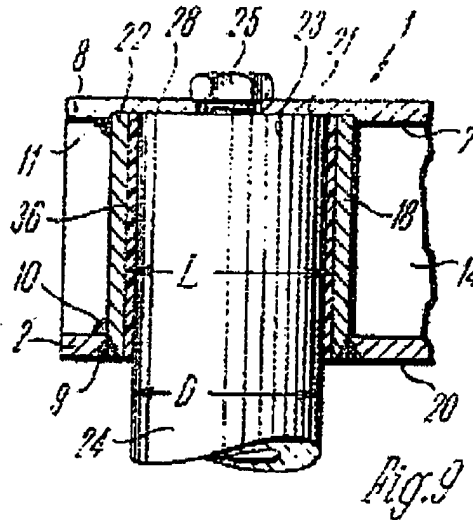


FIG. 9 illustrates an embodiment of the invention which is similar to that as shown in FIGS. 4 to 6 but comprises a connecting rod 24 of tubular shape. In addition, the structural unit according to FIG. 9 is provided with a spacing tube 36, preferably of plastic, which is inserted into the supporting or bracing tube 18 for compensating a difference between the inner width L of tube 36 and the outer diameter D of the end 23 of rod 24.

Claim 1, and thus dependent claims 2, 15, and 16, additionally require the second sleeve to comprise "means for permitting rotation of said third sleeve and said second rake handle within said second sleeve." It is clear from Ernst that the purported "third sleeve" (36) is not made to rotate with bracing tube (18). Moreover, as the structural members are welded together, any purposeful rotation of the "third sleeve" relative to the structural element would provide no known benefit.

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C. Summary

Because there is no motivation to combine Ernst with Wilson et al., and/or because none of the cited combinations of references, including Ernst, teach all of the elements of claims 1, 2, 15, and 16 (*i.e.* at least the third sleeve is not disclosed), the applicant respectfully asserts that claims 1, 2, 15, and 16 are allowable.

35 U.S.C. §102 Rejection of Claims 21 and 22

I. Legal Standards for Anticipation Under 35 U.S.C. §102

Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. *Structural Rubber Products Co., v. Park Rubber Co.*, 749 F.2d 7070; 223 U.S.P.Q. 1264 (Fed. Cir. 1984). Anticipation cannot be predicated on teachings in a reference that are vague or based on conjecture. *Datascope Corp. v. SMEC Inc.*, 594 F. Supp. 1036; 224 U.S.P.Q. 694, 698 (D.N.J. 1984). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The test for anticipation requires that all of the claimed elements must be found in exactly the same situation and united in the same way to perform the same function in a single unit of the prior art. *Studiengesellschaft Kohle, m.b.H. v. Dart Industries., Inc.*, 762 F.2d 724, 726, 220 U.S.P.Q. 841 at 842 (Fed. Cir. 1984).

II. Claims 21 and New Claim 23

The Examiner has rejected claim 21 and canceled claim 22 as being anticipated by U.S. Patent No. 4,514,970 to Wilson, hereinafter "Wilson." In the present office action, claim 22, directed to a method of combining two rakes, has been canceled, and new claim 23, directed to a

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method of combining two rakes, has been added. Therefore, the Examiner's assertions with regard to claim 22 will be addressed with regard to new claim 23.

A. Claim 21

Claim 21 requires a second sleeve that comprises a semi-circular channel for receiving a projection extending radially relative to the second handle—subject matter which is similar to allowed claim 3. As understood, none of the cited references, including Wilson, comprises such a channel. As such, the applicant respectfully asserts that claim 21 is allowable over Wilson.

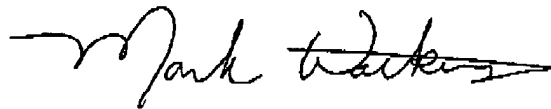
B. Claim 23

Claim 23 similarly requires one of the sleeves to have a channel in the cylindrical wall that receives a projection to facilitate rotation of the first handle relative to the second handle. As understood, none of the cited references, including Wilson, comprise such a channel. As such, the applicant respectfully asserts that claim 23 is allowable over Wilson.

The applicant respectfully asserts that all claims are now allowable, and earnestly requests a notice of allowance be issued in the case.

Respectfully submitted,

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